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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,182	07/25/2001	Katayoon Dehesh	MTC 6796	5251

7590 06/18/2003

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EXAMINER

KALLIS, RUSSELL

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,182

Applicant(s)

DEHESH, KATAYOON

Examiner

Russell Kallis

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,9-21 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,10-16 and 18-21 is/are allowed.
- 6) ☒ Claim(s) 9 and 17 is/are rejected.
- 7) ☒ Claim(s) 31-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3-8 and 22-30 have been cancelled and Claims 1, 2, 9-21, and 31-36 are pending.

Claims 1, 2, 9-21, and 31-36 are examined.

Rejection of Claims 1, 3-21, and 31-36 under 35 U.S.C. 112, first paragraph regarding written description is withdrawn in view of Applicant's amendments and arguments.

Rejection of Claims 1, 3-¹⁰⁻²¹~~8~~, and 31-36 under 35 U.S.C. 112, first paragraph regarding *enablement*

is withdrawn in view of Applicant's amendments and arguments.

Rejection of Claims ~~2~~-8, 10-21³¹ and ~~3~~³¹-36 under 35 U.S.C. 112, second paragraph,

is withdrawn in view of Applicant's amendments and arguments.

Rejection of Claims 9 and 18-21 under 35 U.S.C. 101 is withdrawn in view of Applicant's amendments.

Rejection of Claims 1-8 under 35 U.S.C. 102(b) as being anticipated by Kaneko T. *et al.*, GenBank Accession number S77464 submitted June 1996 from Kaneko T. *et al.*, DNA Research, Vol. 3, pp. 109-136, June 19, 1996 is withdrawn in view of Applicant's amendments and arguments.

Rejection of Claims 1, 7-8, 10-11, 14-16, and 18-21 35 U.S.C. 102(b) as being anticipated by Ferri S. *et al.*, WO98/32770 PCT publication date July 30, 1998 is withdrawn in view of Applicant's amendments.

Rejection of Claims 1, 7-8, 10-21, and 31-36 under 35 U.S.C. 102(b) as being anticipated by Knauf V. *et al.*, U.S. Patent 5,510,255 published April 23, 1996 is withdrawn in view of Applicant's amendments.

Rejection of Claims 1-2, 10-21, and 31-36 under 35 U.S.C. 103(a) as being unpatentable over Knauf *et al.* U.S. Patent 5,510,255 published April 23, 1996 in view of Kaneko T. *et al.*, DNA Research, Vol. 3, pp. 109-136, June 19, 1996 is withdrawn in view of Applicant's amendments.

Rejection of Claims 1-8, 10-11, 14-16, and 18-21 35 U.S.C. 103(a) as being unpatentable over Ferri S. *et al.*, WO98/32770 PCT publication date July 30, 1998 in view of Kaneko T. *et al.*, DNA Research, Vol. 3, pp. 109-136, June 19, 1996 is withdrawn in view of Applicant's amendments.

Claim Rejections - 35 USC § 112

Claim 9 remain⁵ rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant asserts that they have taught soybean plants transformed with SEQ ID NO: 1 that have less than 3.5% weight percent saturated fatty acid on page 31 lines 5-15 of the specification where they teach reduced saturation in T2 generation of soybean seeds (response page 7 line 18 to page 8 line 15). No guidance has been provided for the use of any of a multitude of broadly claimed polynucleotides of Claim 9, wherein only a small fragment of the polynucleotide comprises SEQ ID NO: 1.

Claim Rejections - 35 USC § 101

Claim 17 remains rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed inventions encompass untransformed plants and seeds, which are a product of nature and not one of the five classes of patentable subject matter. The claim limitation "or any part thereof" does not indicate that the part is transgenic. Changing the claim to recite --or any transgenic part thereof-- would obviate this rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claims 9 and 17 remain rejected.

Claims 1, 2, 10-16, and 18-21 are allowed.

Claims 31-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1638

Claims 1, 2, 9-21, and 31-36 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest an isolated polynucleotide of SEQ ID NO: 1 and plants transformed with said polynucleotide.

Art Unit: 1638

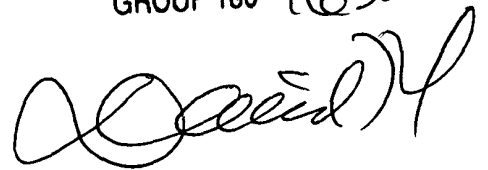
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (703) 305-5417. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Russell Kallis Ph.D.
June 14, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-1638

A handwritten signature in black ink, appearing to read "David T. Fox", written over the printed name and group number.